

## **REMARKS**

Reconsideration of this application is requested in view of the amendments to the claims and the remarks presented herein.

The claims in the application are claims 1 to 16, no other claims having been presented and the claims have now been amended in accordance with the Patent Office rules.

Claims 1 to 10 and 16 were rejected under 35 USC 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. The Examiner states that a broadening aspect is present in the reissue which was not present in the application for patent and the broadening aspect is directed to subject matter that Applicants previously surrendered during the prosecution of the application. Therefore, the narrow scope of the claims in the patent was not an error and the broader scope cannot be recaptured by the filing of the present reissue application. The Examiner referred specifically to compounds having an imidazole nucleus recited in claim 1, histidine as recited in claim 2 and the residue causing destabilization of cell membrane in a weakly acid medium is alkylimidazole as recited in claim 16.

The Examiner was of the opinion that these specific recited limitations relate to embodiments that the Applicant previously surrendered during the prosecution of the original application which became the patent to be reissued. The Examiner alleges that the prosecution history clearly shows that in response to the final rejection dated July 13, 2001 which had prior art rejections drawn specifically to histidine residues or residues with an imidazole nucleus conjugated the polylysine and Applicant introduced a claimed amendment dated October 11, 2001 which clearly shows that the claimed amendment after final was rewritten to omit the very same limitations that were subjected to the prior art rejections as set forth in the final rejection. The Examiner alleges that at an interview on July 31, 2001, Applicants agreed to amend the claims to avoid the prior art.

Applicants respectfully traverse this ground of rejection since Applicants did not limit the claims as alleged by the Examiner in order to obtain allowance of the patent. In response to the office action of July 13, 2001, Applicants filed an amendment on July 17, 2001 and presented claims 45 to 59 in order to overcome the 35 USC 112 rejections. With respect to the prior art cited by the Examiner and the final rejection, Applicants argued against these rejections as can be seen from the copy of the amendment filed herewith. There is no limitation in the claims to delete reference to histidine or residues

with an imidazole nucleus conjugated to polylysine. In the advisory action dated July 31, 2001, the Examiner objected to the claims on the basis of Rule 112 objections and in paragraph 4 of the advisory action, the Examiner wrote that none of the proposed claims had been entered. However, should Applicant correct the issues as indicated below, the proposed claims once corrected would overcome all outstanding rejections. In response thereto, Applicants filed an amendment on September 19, 2001 which was intended merely to clear up the formal matters raised by the Examiner in the advisory action. It was not a limitation of the claims to obviate the prior art rejection since Applicants had already argued against the same and the proposed amendments were not made to avoid the prior art and there is no attempt in the reissue application to recapture subject matter given up during the prosecution of the application.

The amendment of the claims in the reissue were intended to obviate omissions made in the preliminary amendment filed July 23, 1999 which was intended to conform the claims to the American practice and not to unduly limit the claims. There was no prior art rejection, it was merely an inadvertent failure to properly amend the original subject matter as pointed out in the declaration filed with the reissue application. At the time of filing the preliminary amendment, it was overlooked that the preliminary amendment omitted the example of the residue causing a destabilization of cell membranes (for example, histidine) in the third last line of claim 1 as presented. The present amendment in claim 2 reinserts the histidine which was inadvertently omitted in

the preliminary amendment. The cancellation of histidine was not due to a rejection based upon prior art but was merely an inadvertent omission from the original claim 1 in rewriting the same in the preliminary amendment. The Applicant did not give up, as a result of a rejection based on prior art, the compounds having an imidazole nucleus pterines puridines and quinolines of the particular formula since these were set forth in original claim 2 as amended in the preliminary amendment. The amendment to claim 1 merely incorporates language that was taken from the original claims but inadvertently omitted from claim 1 in rewriting the same in the preliminary amendment. Again, there was no surrender of subject matter as a result of a prior art rejection. Applicants amended the claims to obviate the formal matter rejections while arguing the prior art rejections. The Examiner indicated that the claims in the advisory action were free of the prior art and there was not attempt in the present reissue application to recapture subject matter cancelled as a result of a prior art rejection. Therefore, withdrawal of this ground of rejection is requested.

Claims 1 to 10 and 16 were rejected under 35 USC 103 as being obvious over the French '316 patent or the Midoux et al patent taken with Wang et al. This is the same rejection made by the Examiner in the final rejection in the parent application and as can be seen from the copy of the July 17, 2001 amendment filed herewith, Applicants argued against this rejection as not being pertinent and in order to not unduly burden the record of the present application, Applicants incorporate herewith the arguments set forth on

pages 13 to 17 of the July 17, 2001 amendment. As a result of this amendment, the Examiner withdrew the prior art rejection in the advisory action only raising 112 rejections which were overcome by the amendment. As a result of the advisory action of July 31, 2001, Applicants submitted an amendment on September 19, 2001 to obviate the 112 rejections raised by the Examiner in the advisory action. As a result of an interview on September 28, 2001, the undersigned and the Examiner of record discussed the amendment filed on September 19, 2001 and minor changes were made in the amendment of October 5, to obviate certain minor formalities. As stated in the amendment of October 5, 2001, the amendment was to put everything in one amendment. The specification had been amended to insert reference to the PCT application and correct the formula on page 12 and the claims were all cancelled and replaced by the present claims which complied with the amendment of September 19, 2001 with changes to obviate the formal matters. Also submitted was a copy of the Abstract. There were not any amendments made to the claims as a result of the prior art rejections but merely to obviate the formal rejections raised in the advisory action of July 31, 2001 and the Examiner had accepted these claims as being free of the prior art in paragraph 4 of the advisory action wherein the Examiner stated "The proposed claims once amended would overcome all outstanding rejections" which included the prior art rejection argued in the July 19, 2001 amendment.

As a result of the October 5, 2001 amendment, the Examiner made minor changes in an Examiner's Amendment in accordance with the agreement reached at the September 28, 2001 interview. Therefore, it is believed that the claims are patentable over the prior art cited in the parent application for the reasons set forth in the previous rejection.

Claims 1 to 10 and 16 were rejected under the judicially created doctrine of obviousness type double patenting as being obvious over claims 9 to 15 of Patent No. 5,733,762 taken in further view of reference D3. The Examiner concedes that the claims are not identical but alleges that they are not patentably distinct from each other because both sets of claims are readable on a complex between at least one negatively charged nucleic acid and at least one positively charged polymeric conjugate bonded by electrostatic interactions.

Applicants respectfully traverse this ground of rejection since it was the same rejection made in the final rejection in the parent application dated July 13, 2001 and which the Examiner withdrew in view of the arguments set forth in the July 17, 2001 amendment. It is believed that the same arguments which are incorporated herein by reference obviate this ground of rejection for the same reasons that the Examiner withdrew the rejection in the issued patent. Therefore, it is deemed that this rejection is not pertinent and withdrawal of the same is requested.

In view of the amendments to the claims and the above remarks, it is believed that the application is now in condition for acceptance and favorable reconsideration of the application is requested.

Respectfully submitted,  
Muserlian, Lucas and Mercanti

A handwritten signature in black ink, appearing to read 'Charles A. Muserlian', is written over a horizontal line.

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Enclosures